

OBVIOUSNESS-TYPE DOUBLE PATENTING

The Office Action provisionally rejects claims 8, 9, 18 and 47-49 under 35 U.S.C. § 101 as being unpatentable over claims 1, 8 and 21 of co-pending Application No. 09/288,556 under the judicially created doctrine of obviousness-type double patenting. In addition, the Office Action rejects claims 10, 11, 18 and 47-49 under 35 U.S.C. § 101 as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,103,730 under the judicially created doctrine of obviousness-type double patenting.

In response, Applicants respectfully acknowledge the need to cancel claims or to file a Terminal Disclaimer if the rejected claims are ultimately allowed in the above-captioned patent application and such ultimately allowed claims improperly conflict with, or extend the patent right in, the cited copending patent application or issued patent. Applicants respectfully request that these rejections be held in abeyance until the rejected claims are indicated as being allowable. If ultimately deemed necessary, then Applicants will cancel claims or file an appropriate Terminal Disclaimer at that time.

REJECTION UNDER 35 U.S.C. § 103 (a)

The Office Action rejects claims 10, 11 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Klein et al. (U.S. Patent No. 5,807,861) ("Klein"). Applicants respectfully traverse this rejection.

In particular, the above-captioned patent application claims priority from Application No. 08/486,264, now U.S. Patent No. 6,103,730, which in turn is a continuation-in-part of abandoned grandparent Application No. 08/217,051 ("grandparent application"). Applicants respectfully submit that this grandparent application supports the subject matter set forth in claims 10, 11 and 18. In addition, the grandparent application is also the grandparent of Klein. Although it may appear that the subject matter in Klein qualifies as prior art under 35 U.S.C. § 102(e) because the present invention was described in, but not claimed in, a patent granted to another, Applicant respectfully submits that the subject matter disclosed in Klein and claimed in this application, were, at the time the invention was made, commonly owned by Cell Therapeutics, Inc., of Seattle, or subject to an obligation to assign to Cell Therapeutics, Inc., by the inventors.

Applicants concurrently submit herewith copies of the Assignment documents for the above-captioned patent application (Exhibit A) and for Klein (Exhibit B), as recorded in the Patent Office. In view of the common ownership believed to be established by the attached Assignment documents, Applicants respectfully request reconsideration and withdrawal of this rejection.

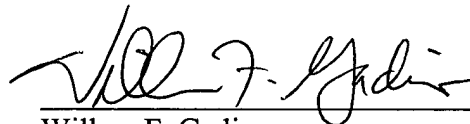
CONCLUSION

For the foregoing reasons, Applicant respectfully requests favorable consideration and prompt allowance of the pending claims.

Please grant any extension of time deemed necessary for entry of this communication. Please charge any deficient small entity fees, or credit any overpayment of fees, to Deposit Account No. 50-0417. A duplicate copy of this communication is attached.

Respectfully submitted;

Date: June 4, 2003

By: 
Willem F. Gadiano
Registration No. 37,136

MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, D.C. 20005-3096
Telephone: (202) 756-8000
Facsimile: (202) 756-8087



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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, D.C. 20231

FEBRUARY 02, 2001

MCDERMOTT, WILL & EMERY
WILLEM F. GADIANO
600 13TH STREET, N.W.
WASHINGTON, D.C. 20005

PTAS



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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 11/14/2000

REEL/FRAME: 011283/0329
NUMBER OF PAGES: 8

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

KLEIN, J. PETER

DOC DATE: 11/08/2000

ASSIGNOR:

KLAUS, STEPHEN J.

DOC DATE: 10/27/2000

ASSIGNOR:

KUMAR, ANIL M.

DOC DATE: 11/07/2000

ASSIGNOR:

GONG, BAOQING

DOC DATE: 11/07/2000

ASSIGNEE:

CELL THERAPEUTICS, INC.
201 ELLIOTT AVENUE WEST
SUITE 400
SEATTLE, WASHINGTON 98119

SERIAL NUMBER: 09544984
PATENT NUMBER:

FILING DATE: 04/07/2000
ISSUE DATE:

011283/0329 PAGE 2

· DIANE RUSSELE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

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U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

12-04-2000



101535629

Docket No.: 44033-093

To the Honorable Commissioner of Patent:

original documents or copy thereto:

1. Name of Conveying Party(ies):

J. Peter KLEIN, Stephen J. KLAUS, Anil M. KUMAR, and
Baoqing GONGAdditional name(s) of conveying party(ies) attached? ☐ Yes

3. Nature of Conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other

Execution Date: Nov. 8, Oct. 27, Nov. 7, and Nov. 7, 2000
(respectively)

2. Name and address of receiving party(ies):

Name: CELL THERAPEUTICS, INC.

Address: 201 Elliott Avenue West
Suite 400
Seattle, Washington 98119Additional name(s) & address(es) attached? ☐ Yes

4. Application number(s) or patent number(s):

If the document is being filed together with a new application, the execution date of the application is:

A. Patent Application No(s).

09/544,984-Filed April 7, 2000

B. Patent No(s).

Additional numbers attached? ☐ Yes5. Name and address of party to whom correspondence
concerning document should be mailed:

Name: MCDERMOTT, WILL & EMERY

Internal Address:

Street Address: 600 13th Street, N.W.

City: Washington State: DC Zip: 20005

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41) \$40.00

- ☐ Enclosed
☒ Authorized to be charged to deposit account

8. Deposit account number:

500417

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Willem F. Gadiano, 37,136

November 14, 2000

Name and Registration No. of Person Signing

Signature

Date

Total number of pages comprising cover sheet: 1

CMB No. 0851-0011 (exp. 4/94)

09/544,984-Filed April 7, 2000
10.00 OF

ASSIGNMENT OF PATENT RIGHTS

WHEREAS, J. Peter KLEIN, a citizen of the United States of America presently residing at 18822 Ridge Rd. S.W., Vashon, Washington 98070 (U.S.A.), **Stephen J. KLAUS**, a citizen of the United States of America presently residing at 372 Central Park West, #11XY, New York, New York 10025 (U.S.A.), **Anil M. KUMAR**, a citizen of India presently residing at 13701 113th Street Court E., Puyallup, Washington 98374 (U.S.A.), and **Baoqing GONG**, a citizen of China presently residing at 2324 N. 178th Street, Shoreline, Washington 98133 (U.S.A.) (hereinafter all referred to as "Assignors," "we," "they," or "them"), have invented a new and useful Invention entitled, "THERAPEUTIC COMPOUNDS FOR INHIBITING INTERLEUKIN-12 SIGNALING AND METHODS FOR USING SAME," for which a United States Patent Application was filed on April 7, 2000, having Application Serial No. 09/544,984; and

WHEREAS, CELL THERAPEUTICS, INC., a corporation organized and existing under the laws of the State of Washington, having a place of business at 201 Elliott Avenue West, Suite 400, Seattle, Washington 98119 (U.S.A.) (hereinafter referred to as "Assignee"), is desirous of acquiring, for the United States of America and all countries foreign to the United States of America, the entire right, title and interest in, to and under (1) the Invention, (2) all patent applications that may be filed for the Invention and that may ultimately claim the benefit of priority from the filing date of the above-identified United States Application, and (3) any Letters Patent that may be granted for said Invention, as hereinafter more fully set forth:

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN, in consideration of the sum of One Dollar (\$1.00) to the Assignors in hand paid, and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Assignors, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the Assignee, its successors, legal representatives and assigns, the entire right, title and interest in, to and under the Invention, and all applications for Letters Patent that may hereafter be filed for said Invention in any country and all Letters Patent that may be granted for said Invention in any country (including, without limitation, all extensions, renewals, reissues, reexaminations and the like thereof and such other forms of protection of industrial property as may be provided by any country), and all rights of priority in any country that are based upon the filing date of the above-identified United States Application and that are created by any law, treaty or international convention; the above transferred right, title and interest to be held and enjoyed by said Assignee, its successors, legal representatives and assigns as fully and entirely as the same would have been held and enjoyed by the Assignors had this assignment not been made;

AND THE ASSIGNORS HEREBY authorize and request all appropriate and competent Officials in all countries, whose duty it is to issue or grant Letters Patents on applications as aforesaid, to issue or grant all Letters Patent for said Invention to the Assignee, its successors, legal representatives and assigns, in accordance with the terms of this instrument;

AND THE ASSIGNORS HEREBY represent and covenant that they have the full right to convey the entire interest herein assigned and that they have not executed, and will not execute, any agreement in conflict herewith;

AND THE ASSIGNORS HEREBY further covenant and agree that, at the request and expense of the Assignee, its successors, legal representatives and assigns, but without demanding further consideration therefor, they will (1) assist in the prosecution of all applications for Letters Patent as herein described and any other applications for Letters Patent that may be made covering said Invention; (2) communicate any and all facts known to them respecting said Invention; (3) testify in any legal proceeding involving said Invention; (4) execute and acknowledge all lawful papers and legal instruments; (5) execute all divisional, continuing, reissue and reexamination applications; (6) make all rightful oaths; and (6) generally do any and every lawful act deemed necessary to aid and cooperate with the Assignee, its successors, legal representatives and assigns in perfecting and maintaining the entire interest conveyed herein and in obtaining and enforcing proper patent or industrial property protection for said Invention in any country, particularly in cases of opposition, interference and litigation;

AND THE ASSIGNORS HEREBY covenant and agree that the rights and obligations set forth in this instrument shall be binding upon, and inure to the benefit of, their heirs, legal representatives, successors and assigns;

AND THE ASSIGNORS HEREBY grant the Assignee, its successors, legal representatives and assigns, the power to insert on this instrument any further identification that may be necessary or desirable to comply with the recordation rules of any appropriate and competent authority, including, without limitation, the United States Patent and Trademark Office.

AND THE PARTIES HEREBY agree that this Assignment may be executed in two or more counterparts each of which shall be deemed an original but all of which together shall constitute one and the same instrument.

IN TESTIMONY WHEREOF, the Assignors and Assignee hereunto sets their hands and seals the day and year set opposite their signatures.

SIGNATURES BEGIN ON THE NEXT PAGE

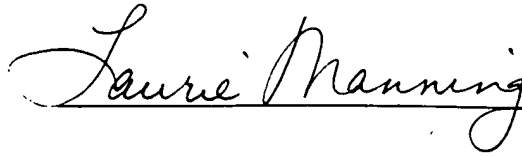
Date: 11/8/00



J. PETER KLEIN

WITNESSED BY:

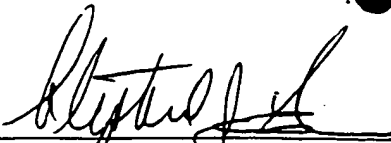
Date: 11/8/00



Date: _____

Date:

10/27/00



STEPHEN J. KLAUS

WITNESSED BY:

Date:

Date:

Date: 11/07/00

M. Anil
ANIL M. KUMAR

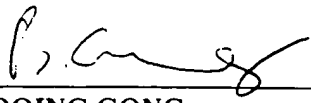
WITNESSED BY:

Date: 11/7/00

Lauree Phanning

Date: _____

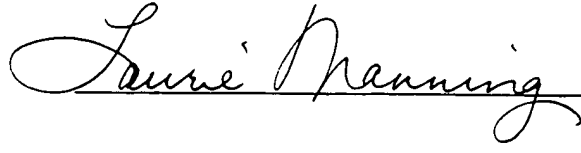
Date: 11/7/00



BAOQING GONG

WITNESSED BY:

Date: 11/7/00



Date: _____

BY ASSIGNEE: -

Date: 11-8-00

CELL THERAPEUTICS, INC.
201 Elliott Avenue West, Suite 400
Seattle, Washington 98119
U.S.A.

BY: *Louis A. Bianco*

PRINTED: Louis A. Bianco

WITNESSED BY:

Date: 11-8-00

Date: _____

Carol J. Therrell



JANUARY 22, 1996



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WILHELM F. GADIANO
WILLIAM BRINKS HOFER GILSON & LIONE
2000 K STREET, N.W., STE. 200
WASHINGTON, DC 20006-1809

JAN 25 1996

WILLIAM BRINKS
HOFER GILSON & LIONE
WASHINGTON, D.C.

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RECORDATION DATE: 08/18/1995

REEL/FRAME: 7618/0637
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
KLEIN, J. PETER

DOC DATE: 06/06/1995

ASSIGNOR:
UNDERINER, GAIL E.

DOC DATE: 06/22/1995

ASSIGNOR:
KUMAR, ANIL M.

DOC DATE: 06/22/1995

ASSIGNOR:
RIDGERS, LANCE H.

DOC DATE: 06/08/1995

ASSIGNOR:
RICE, GLENN C.

DOC DATE: 06/26/1995

ASSIGNOR:
LEUNG, DAVID W.

DOC DATE: 06/27/1995

ASSIGNEE:
CELL THERAPEUTICS, INC.
201 ELLIOTT AVENUE WEST, STE. 400
SEATTLE, WASHINGTON 98119

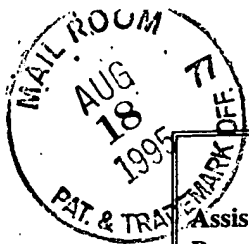
NO DUE DATE *aw*

7618/0637 PAGE 2

SERIAL NUMBER: 08476911
PATENT NUMBER:

FILING DATE: 06/07/1995
ISSUE DATE:

JERYL MCDOWELL, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS



40-58
8-18-95

09-20-1995

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61329

U.S. PTO



09/20/95

Attorney Docket No. 7605-20

To the Honorable Assistant Commissioner for Patents:
Please record the attached original documents or copy thereof.

1. A. Name of conveying party(ies):

J. Peter Klein, Gail E. Underiner, Anil M. Kumar,
Lance H. Ridgers, Glenn C. Rice, David W. Leung

B. Additional conveying party(ies) name(s) attached?
 Yes X No

2. A. Name and address of receiving party(ies):

Cell Therapeutics, Inc.
201 Elliott Avenue West, Suite 400
Seattle, Washington 98119

B. Additional name(s) & address(es) attached?
 Yes X No

3. A. Nature of conveyance:

 X Assignment Merger
 Security Agreement Change of Name
 Other

B. Execution Date:

4. A. If this document is being filed together with a new application, the execution date of the application is:

B. Patent Application No.(s)

08/476,911

C. Patent No.(s)

D. Additional numbers attached? Yes X No

5. Name and address of party to whom
correspondence concerning document should be
mailed:

Name: Wilhlem F. Gadiano

Address: Willian Brinks Hofer Gilson & Lione
2000 K Street, N.W., Suite 200
Washington, DC 20006-1809

6. Total number of applications
and patents involved: 1

7. Total fee (37 CFR 3.41).....\$ 40.00

Enclosed (Check No. 02283)

8. Credit any overpayment or charge any
underpayment to deposit account number:
23-1920

9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached
copy is a true copy of the original document.*

Wilhlem F. Gadiano

Wilhlem F. Gadiano
Registration No. 37,136

Date: 8/18/95

Total number of pages including cover sheet, attachments, and document: 2

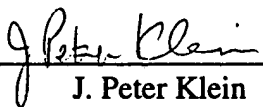
ASSIGNMENT

WHEREAS, We J. Peter Klein, Gail E. Underiner, Anil M. Kumar, Lance H. Ridgers, Glenn C. Rice, and David W. Leung, residing at 18822 Ridge Road S.W., Vashon, Washington 98070; 3160 243rd Street S.W., Brier, Washington 98036; 13407 Greenwood Avenue N., #211, Seattle, Washington 98133; 16720 North Road, #B208, Bothell, Washington 98012, respectively, are the inventors named in a United States Patent Application entitled "AMINE SUBSTITUTED COMPOUNDS", filed June 7, 1995;

AND, WHEREAS, CELL THERAPEUTICS, INC., a corporation of the State of Washington, having a principal place of business at 201 Elliott Avenue West, Suite 400, Seattle, Washington 98119, USA (hereinafter referred to as ASSIGNEE) is desirous of acquiring the entire right, title and interest in the invention described in said application;

NOW, THEREFORE, for sufficient, good and valuable consideration, the receipt of which is hereby acknowledged, we do hereby sell, assign, and transfer unto said ASSIGNEE, our entire right, title to and interest in said application and said inventions and all applications and patent on said invention(s) to be held and enjoyed by ASSIGNEE as entirely as the same would have been held and enjoyed by us had this sale, assignment, and transfer not been made, and we do hereby further agree and promise to execute all instruments and render all such assistance as ASSIGNEE may request in order to make and prosecute any and all applications on said invention(s), to enforce any and all patents on said invention(s), and to confirm in ASSIGNEE legal title to said invention(s) and all applications and patents on said invention(s), all without charge to ASSIGNEE but at no expense to us.

Executed at Seattle, Washington, this 6th day of June, 1995.



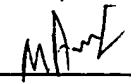
J. Peter Klein

Executed at Seattle, Washington, this 22 day of June, 1995.



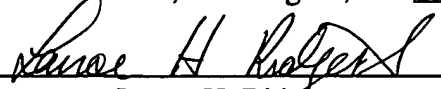
Gail E. Underiner

Executed at Seattle, Washington, this 22 day of June, 1995.



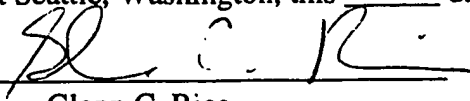
Anil M. Kumar

Executed at Seattle, Washington, this 5 day of June, 1995.



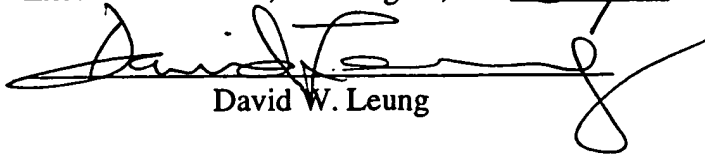
Lance H. Ridgers

Executed at Seattle, Washington, this 26 day of June, 1995.



Glenn C. Rice

Executed at Seattle, Washington, this 27 day of June, 1995.



David W. Leung